

**Amendment and Response**

Applicant: Winthrop D. Childers et al.

Serial No.: 10/634,024

Filed: August 4, 2003

Docket No.: 10971935-17

Title: INK DELIVERY SYSTEM ADAPTER

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**REMARKS**

The following remarks are made in response to the Office Action mailed April 4, 2006, in which claims 39-51 were rejected. With this Response, claims 39-43 have been amended. Claims 39-51 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 112**

Claims 39-51 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, with respect to claim 39, the Office Action stated it is not understood how the ink container can “miss” a memory device. With respect to claim 43, the Office Action found the recitations of “information” and “memory device” throughout the claim to be confusing.

With this Amendment, independent claims 39 and 43 have been amended to remove or clarify the language alleged to be unclear. Dependent claims 40-42 and 44 have been amended to conform to the language of the amended independent claims 39 and 43. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

**Claim Rejections under 35 U.S.C. § 102(e)**

Claims 39 and 41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fujii (U.S. Patent No. 5,980,030).

As amended, independent claim 39 is directed towards:

An emulator for use in a printing system, the printing system having a controller and being configured to receive a replaceable ink container having replacement ink therein and replacement ink information associated therewith, the replaceable ink container without a memory device attached thereto for storing the replacement ink information, the emulator comprising:

an electrical signal source separate from and not coupled to the replaceable ink container for exchanging the replacement ink information with the controller; and

a flexible cable operatively coupled to the electrical signal source and configured to separably electrically connect to the controller.

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Under 35 U.S.C. §102, the cited reference must show each and every feature of the claimed invention. Extension of or speculation as to the cited teaching is permitted only when *necessarily present* in the disclosed apparatus or method. In other words, if a particular feature is not specifically disclosed it can only be relied upon under 35 U.S.C. §102 if and only if such feature is necessarily present in the disclosed apparatus or method. See, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”), and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim”).

Applicants respectfully submit that Fujii fails to show each and every feature of amended independent claim 39. In particular, Applicants submit that Fujii makes no teaching or suggestion regarding *at least* the claim elements “the printing system . . . being configured to receive a replaceable ink container” and “a flexible cable operatively coupled to the electrical signal source and configured to separably electrically connect to the controller.” Further, such features are not *necessarily present* in the disclosed apparatus.

First, Fujii does not teach or suggest the printing system being configured to receive a replaceable ink container. In fact, the ink tank 1 and ink reservoir 14 of Fujii are not replaceable. See, for example, Fujii at col. 3, lines 4-6, stating that ink reservoir 14 is permanently installed above ink tank 1. There is simply no teaching or suggestion in Fujii that ink tank 1 and/or ink reservoir 14 are replaceable, and such a feature is not necessarily present in Fujii.

Second, Fujii does not teach or suggest a flexible cable operatively coupled to the electrical signal source and configured to separably electrically connect to the controller. Fujii teaches a controller 30 including a CPU 32 and memory 33 connected via bus lines 31. The Office Action equates the CPU 32, memory 33 and bus lines 31 of Fujii with the controller, signal source and flexible cable, respectively, of claim 39. However, Applicants respectfully submit that, contrary to the characterization set forth in the Office Action, Fujii makes no teaching or suggestion that bus lines 31 (i.e., the alleged flexible cable) are either a cable or flexible. The bus lines 31 may be, for example, traces on a printed circuit board.

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There is certainly is no teaching or suggestion in Fujii that bus lines 31 *necessarily* take the form of a flexible cable, as set forth in claim 39. In addition, Fujii makes no teaching or suggestion that bus lines 31 are configured to separably electrically connect to the controller, as set forth in claim 39. There certainly is no teaching or suggestion in Fujii that the noted claim element is *necessarily present*. For at least these reasons, Applicants respectfully submit Fujii fails to teach or suggest each and every feature of the invention as set forth in amended independent claim 39. Accordingly, withdrawal of the rejection of claim 39 under 35 U.S.C. §102(e) is respectfully requested.

Claim 41 depends directly from independent claim 39 which is not anticipated by Fujii for at least the reasons set forth above. Accordingly, dependent claim 41 is also not anticipated by Fujii, and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

**Claim Rejections under 35 U.S.C. § 103**

Claims 39-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Bullock et al. (U.S. 5,812,156) in view of Fujii (U.S. 5,980,030).

Applicants respectfully submit that the Bullock et al. reference is not properly considered as prior art against the present application in a rejection under 35 U.S.C. § 103(a). In particular, the present application is a continuation of U.S. Patent application serial number 09/975,295, filed on October 10, 2001 (now U.S. Patent number 6,619,789), which is a continuation of U.S. Patent application serial number 09/125,086, filed on August 7, 1998 (now U.S. Patent number 6,322,205). The Bullock et al. reference issued as a patent on September 22, 1998. Accordingly, Bullock et al. qualifies as prior art only under §102(e). Notably, Bullock et al. was cited as a §102(e) reference in the Office Action mailed August 30, 2005.

35 U.S.C. §103(c) indicates that subject matter which qualifies as prior art only under §102(e) is not usable in a §103(a) obviousness rejection if the subject matter and the claimed invention were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. MPEP §706.02 (1)(3), §706.07(a). At the time of the invention, Bullock et al. and the present application were subject to an obligation of assignment to Hewlett Packard Company as evidenced by the accompanying "Statement

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---

Regarding Common Ownership”. As such, the rejections under §103(a) relying upon Bullock et al. are traversed, and withdrawal of the rejection of claims 39-51 on such grounds is respectfully requested.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 39-51 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 39-51 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

Any inquiry regarding this Amendment and Response should be directed to either Matthew B. McNutt at Telephone No. (612) 767-2510, Facsimile No. (612) 573-2005 or Thomas A. Jolly at Telephone No. (541) 715-7331, Facsimile No. (541) 715-8581. In addition, all correspondence should continue to be directed to the following address:

IP Administration  
Legal Department, M/S 35  
HEWLETT-PACKARD COMPANY  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

Respectfully submitted,

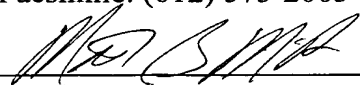
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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of June, 2006.

By   
Name: Matthew B. McNutt